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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,452	08/16/2001	Koji Nagata	35.C15682	1317

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EXAMINER	
DIVINE, LUCAS	

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/930,452	NAGATA, KOJI	
	Examiner	Art Unit	
	Lucas Divine	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *16 August 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 August 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "**303**" has been used to designate both the print type and background box of Fig. 3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 10 – 15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The computer program claimed is merely a set of

instructions per se. Since the computer program is merely a set of instructions not embodied on a computer readable medium to realize the computer program functionality, the claimed subject matter is non-statutory. See MPEP § 2106 IV.B.1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 6, 7, and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Gunning et al. (US 6094548) hereafter as Gunning.

Regarding claim 1, Gunning teaches **a print control apparatus** (Fig. 1) **for processing a printing request from an application** (28 as controlled by 16 and 24, Fig. 2) **and forming print data which can be printed by a printer** (page is scanned in to form print data for subsequent printing; printer 12)**, comprising:**

paper size setting means (Fig. 4 shows the graphical user interface that selects paper sizes and sends instructions to the copy processor 16 [see Fig. 2], wherein the processor acts as paper size setting means to actually control the operation of the copier using the selections of the user) **for setting an input paper size of a document which is inputted from the application** (the user application controls the GUI; paper size is the input page size) **and an output paper**

size of print data which is printed by said printer (Fig. 4 shows paper tray setting including the output size [see LTR, A4, and it is implied that other sizes could be loaded as well]); **and**

forming means for forming the print data on the basis of the input paper size and the output paper size (a copied sheet is formed by scanning 14 the document [referring to input size], transforming the data, and printing the data with engine 22 with paper size selected by paper tray selection [output paper size]) **which are set by said paper size setting means,**

wherein when said input paper size is set (Fig. 4 paper size column is set to LTR), **said paper size setting means displays a paper size which is supported by said printer** (Fig. 4, the paper sizes supported are displayed in the right column under paper tray) **and a paper size which is not supported by said printer** (Fig. 4, paper sizes in the left column [paper size] that are not in the right column [paper tray] are paper sizes not supported by the printer in current configuration and they are displayed to the user) **so that they can be discriminated** (a user can thus discriminate whether a size they desire in the left column is printed by the copier with the current settings).

Regarding claim 2, which depends from claim 1, Gunning further teaches that **paper size setting means sets the input paper size and the output paper size in response to an instruction which is inputted through a graphical user interface for performing a print setting** (the paper size setting means as discussed in the rejection to claim 1 receives user paper setting commands from the interactive menu [Fig. 4] used in the user interface 28; col. 2 line 18).

Regarding claim 6, the structural elements of apparatus claim 1 perform all of the method steps of method claim 6. Therefore, method claim 6 is rejected for the same reasons as stated above in the rejection of apparatus claim 1.

Regarding claim 7, which depends from claim 6, the structural elements of apparatus claim 2 perform all of the method steps of method claim 7. Therefore, method claim 7 is rejected for the same reasons as stated above in the rejection of apparatus claim 2.

Regarding claim 16, which depends from claim 11, the method steps of method claim 6 are the same steps as performed by program claim 16. Further, Gunning teaches a processor 16 to execute program steps and a computer readable medium 30 to store program steps. Therefore, program claim 16 is rejected for the same reasons as stated above in the rejection of method claim 6.

Regarding claim 16, which depends from claim 12, the method steps of method claim 7 are the same steps as performed by program claim 16. Further, Gunning teaches a processor 16 to execute program steps and a computer readable medium 30 to store program steps. Therefore, program claim 16 is rejected for the same reasons as stated above in the rejection of method claim 7.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 5, 10, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gunning as applied to claims 1, 6, and 15 above, and further in view of Webb et al. (US 5727135) hereafter as Webb.

Regarding claim 5, which depends from claim 1, Gunning does not specifically that paper size setting means adds a mark showing that the paper size is not supported to a position near a paper name of the input paper size corresponding to the paper size which is not supported by said printer and displays them.

Webb teaches adding and displaying a mark showing that an unavailable printing resource is unavailable, displaying the mark near to the name of the resource (Fig. 8, wherein mark 306 shows that the printer 304 is unavailable).

It would have been obvious to one of ordinary skill in the art that this type of user notification could be used to also let the user know that other printer resources are unavailable or unsupported, such as the paper size of Gunning. The motivation for doing so would have been to clearly notify the user that certain resources are unavailable.

Regarding claim 10, which depends from claim 6, the structural elements of apparatus claim 5 perform all of the method steps of method claim 10. Therefore, method claim 10 is rejected for the same reasons as stated above in the rejection of apparatus claim 5.

Regarding claim 16, which depends from claim 15, the method steps of method claim 10 are the same steps as performed by program claim 16. Further, Gunning teaches a processor 16 to execute program steps and a computer readable medium 30 to store program steps. Therefore, program claim 16 is rejected for the same reasons as stated above in the rejection of method claim 10.

6. Claims 3, 4, 8, 9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gunning as applied to claims 1, 6, and 11 above, and further in view of Morikawa (US 6741269).

Regarding claim 3, which depends from claim 1, while Gunning teaches the reducing and/or enlarging of documents to fit paper sizes that the user selects (see Fig. 4, reduce/enlarge tab) and the user can thus see what paper sizes are not available with the current settings and reduce/enlarge accordingly, Gunning does not specifically teach automatically setting a zooming print in the case where the input paper size which is set by said paper size setting means is the paper size which is not supported by said printer.

Morikawa teaches automatically setting an enlarge/reduce print in the case where the input paper size is different from the output size (col. 6 lines 3-7).

It would have been obvious to one of ordinary skill in the art that when a paper size is unsupported and the document must be reduced/enlarged to be printed that an automatic scaling could be performed as is shown in Morikawa. The motivation for doing so would have been to take the burden off the user, who can be imprecise and allow the processor to handle the enlarging/reducing calculations for a more accurate scaling than if the user completed the task alone.

Regarding claim 4, which depends from claim 3, Morikawa further teaches the printing method can be changed by manual operation (Fig. 3 shows the user being able to select scaling ranges [see 93% and 100%]; col. 6 lines 9-10, wherein the operator touches keys to initiate scaling of the page size).

Regarding claim 8, which depends from claim 6, the structural elements of apparatus claim 3 perform all of the method steps of method claim 8. Therefore, method claim 8 is rejected for the same reasons as stated above in the rejection of apparatus claim 3.

Regarding claim 9, which depends from claim 8, the structural elements of apparatus claim 4 perform all of the method steps of method claim 9. Therefore, method claim 9 is rejected for the same reasons as stated above in the rejection of apparatus claim 4.

Regarding claim 16, which depends from claim 13, the method steps of method claim 8 are the same steps as performed by program claim 16. Further, Gunning teaches a processor 16 to execute program steps and a computer readable medium 30 to store program steps. Therefore, program claim 16 is rejected for the same reasons as stated above in the rejection of method claim 8.

Regarding claim 16, which depends from claim 14, the method steps of method claim 9 are the same steps as performed by program claim 16. Further, Gunning teaches a processor 16 to execute program steps and a computer readable medium 30 to store program steps. Therefore, program claim 16 is rejected for the same reasons as stated above in the rejection of method claim 9.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lucas Divine
Examiner
Art Unit 2624

ljd

KING Y. POON
PRIMARY EXAMINER